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Craig L. Reding

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VERIZON  
PATENT MANAGEMENT GROUP  
1320 North Court House Road  
9th Floor  
ARLINGTON, VA 22201-2909

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ELAHEE, MD S

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

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## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is responsive to an amendment filed on 09/09/2010. Claims 1-14 and 19-26 are pending. Claims 15-18 have been canceled.

### ***Response to Arguments***

2. Applicant's arguments filed in 09/09/2010 remarks have been fully considered but they are not persuasive because of the following:

Regarding claim 1, the applicant argues on pages 15-16 that Cloutier does not teach determining whether the preferred device is available to receive the notification without transmitting the notification to the preferred device. Examiner respectfully disagrees with this argument. It is because, in col. 1 lines 13-23, col. 3 lines 18-43, col. 6 lines 1-35, col. 8 lines 8-65, Cloutier teaches this limitation. Cloutier teaches user's can specify complex conditions that process each alert to determine whether the subscriber should be alerted via one of the available devices (abstract, col. 1 lines 25-67). The subscriber profile specifies possible devices through which the subscriber may be alerted via a schedule corresponding to each of the devices (abstract, see col. 1 lines 25-67 wherein profile also includes a priority level corresponding to each of the devices during time periods when multiple devices are available). Cloutier even discloses a set of conditions that are specified by the subscriber (col. 4 lines 5-23) which include parties from which notifications are to be transmitted to the preferred communications device.

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Cloutier teaches using an availability field (col. 6 lines 1-35) to indicate the time when each of the devices may be used to alert the subscriber and the priority in which the device should be used when more than one device are available. Cloutier discloses that the subscriber may modify the subscriber profile by adding other devices that may be accessible and the time periods that each of the devices may be used (col. 6 lines 1-35). Thus it is clear that the preferred device will be not available if the device is not within a particular scheduled time for receiving the alert. In other word, Cloutier teaches determining whether the preferred device is available to receive the notification without transmitting the notification to the preferred device.

Thus, the rejection of the claim will remain. The rejection of the claims 12, 19 and 26 will remain for the same reasons as discussed above with respect to claim 1.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 26 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would

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result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

5. Claim 26 recites a non-transitive computer-readable medium comprising encoded with instructions capable of being executed by a processor. Claim language does not comply with the requirements of MPEP 2106.01.I. The “medium” is only recited once in the invention disclosure (Preamble of Claim 26). Since “medium” is not defined in the disclosure, it may encompass a variety of media ranging from a piece of paper to a carrier signal. Furthermore, “computer program” or “software” is merely a set of instructions. On the contrary, “memory”, “computer program” and “software” are well defined acceptable terminology in computer programming. Additionally, comprising is not an acceptable linking word to associate “computer readable medium” to a “computer program product”. Computer program is data structure. The claimed instructions are merely data structure. Data structures not claimed as embodied in computer-readable or machine-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer or machine. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1754 (claim to a data structure per se held nonstatutory). Claim 26 fails to include practical application that produces either (1) tangible, concrete and useful result or (2) physical transformation. Therefore, since the claimed computer-readable medium does not comprise instructions to cause a processor to perform the storing, receiving, converting and transmitting functions of the claim then the Applicant has not complied with 35 U.S.C 101.

Note that a claim drawn to such a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. § 101 by adding the limitation "non-transitory" to the claim.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 6-12 of co-pending application no. 10/720,920. Because claim in the pending application is broader than the one in co-pending application, In re Van Ornum and Stang, 214 USPQT61, broad claims in the pending application are rejected as obvious double patenting over previously patented narrow claims. For example, claim 1 of the pending application are the same as claim 1 of the co-pending application except receiving a notification at a server.

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8. Claims 1-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-37 and 110 of co-pending application no. 10/858,973. Because claim in the pending application is broader than the one in co-pending application, In re Van Ornum and Stang, 214 USPQT61, broad claims in the pending application are rejected as obvious double patenting over previously patented narrow claims. For example, claim 1 of the pending application are the same as claim 1 of the co-pending application except displaying step.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-14, 19-21 and 23-26 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Cloutier (US 6,459,913).

Regarding claims 1, 12, 19, 26, with respect to Figures 1-3 and 9, Cloutier teaches a method comprising:

storing data reflecting a preferred device upon which a user prefers to receive notifications of incoming calls, the preferred device being one of a plurality of devices associated with the user (fig.9, step 1006; col.3, lines 18-43, col.8, lines 17-23, 52-55);

Cloutier further teaches receiving incoming call data indicating an incoming call directed to one of the plurality of devices associated with the user from a calling device associated with a caller, the incoming call data being in a format for the calling device (fig.9, step 1000; col.8, lines 17-23, 37-42);

Cloutier further teaches generating a notification of the incoming call from the incoming call data, wherein the incoming call data converted into a data format for the preferred device (fig.9, step 1014; col.6, lines 62-67, col.9, lines 11-24);

Cloutier further teaches determining whether the preferred device is available to receive the notification without transmitting the notification to the preferred device (abstract; fig.9; col. 1 lines 13-23, col. 3 lines 18-43, col. 6 lines 1-35, col. 8 lines 8-65). (Note; Cloutier teaches **user's can specify complex conditions** that process each alert to determine whether the subscriber should be alerted via one of the available devices (abstract, col. 1 lines 25-67). The subscriber profile specifies possible devices through which the subscriber may be alerted via a schedule corresponding to each of the devices (abstract, see col. 1 lines 25-67 wherein profile also includes a priority level corresponding to each of the devices during time periods when multiple devices are available). Cloutier even discloses a set of conditions that are specified by the subscriber (col. 4 lines 5-23) which include parties from which notifications are to be transmitted to the preferred communications device. Cloutier teaches using an availability field (col. 6 lines 1-35) to indicate the time when each of the devices may be used to alert the

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subscriber and the priority in which the device should be used when more than one device are available. Cloutier discloses that the subscriber may modify the subscriber profile by adding other **devices that may be accessible and the time periods that each of the devices may be used** (col. 6 lines 1-35). Thus it is clear that the preferred device will be not available if the device is not within a particular scheduled time for receiving the alert.); and

Cloutier further teaches based on the determination that the preferred device is available to receive the notification, transmitting the notification to the user's preferred device (fig.9, step 1032; col.9, lines 22-24).

Regarding claim 2, Cloutier, as applied to claim 1, teaches receiving user selection of the preferred device (fig.9, step 1006).

Regarding claims 3, 14 and 21, Cloutier, as applied to claims 1, 13 and 20, teaches that receiving a user selection of a time period during which notifications are to be transmitted to the preferred device (col.6, lines 1-35, 53-62).

Regarding claim 4, Cloutier, as applied to claim 1, teaches that receiving a user selection of a device for which notifications are to be transmitted to the preferred device (fig.9, step 1006; col.6, lines 1-35, col.8, lines 52-55).

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Regarding claims 5 and 20, Cloutier, as applied to claims 1 and 19, teaches receiving a user selection of calling parties from which notifications are to be transmitted to the preferred device (col.4, lines 5-22).

Regarding claim 6, Cloutier, as applied to claim 5, teaches that the user selection of calling parties comprises using a calendar function for specifying date-specific notifications (col.6, lines 1-35, 53-62).

Regarding claim 7, Cloutier, as applied to claim 1, teaches receiving user specifications for receiving notifications by a preferred device based on at least one of the time of day or calling party (col.6, lines 1-35, 53-62).

Regarding claim 8, Cloutier, as applied to claim 2, teaches that receiving user selection of the preferred device comprises receiving selection of a wireless phone capable of displaying text messages (col.3, lines 18-43, col.7, lines 29-33, col.8, lines 17-23, 52-55).

Regarding claim 9, Cloutier, as applied to claim 2, teaches that receiving user selection of the preferred device comprises receiving selection of a landline phone (col.3, lines 18-43, col.7, lines 1-7, 53-60, col.8, lines 24-35).

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Regarding claim 10, Cloutier, as applied to claim 2, teaches that receiving user selection of the preferred device comprises receiving selection of a desktop or laptop computer (col.3, lines 18-43, col.7, lines 1-7, 53-60, col.8, lines 24-35).

Regarding claim 11, Cloutier, as applied to claim 2, teaches that receiving user selection of the preferred device comprises receiving selection of a handheld device (col.7, lines 29-33).

Regarding claim 13, Cloutier, as applied to claim 12, teaches that a database for storing identifications of calling parties from whom notifications are transmitted to the preferred device (col.4, lines 5-22).

Regarding claims 23 and 24, Cloutier, as applied to claim 1, teaches that the user's preferred device is a phone/an instant message client, and the incoming call data is converted into a text message notification/an instant message notification of the incoming call (fig.9, step 1014; col.6, lines 62-67, col.9, lines 11-24).

Regarding claim 25, Cloutier, as applied to claim 1, teaches that the incoming call is directed to one of the plurality of devices other than the preferred device (fig.9, step 1000; col.8, lines 17-23, 37-42).

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cloutier in view of Chin (U.S. Patent No. 5,661,788).

Regarding claim 22, Cloutier, as applied to claim 1, does not specifically teach blocking the notification to the preferred device when the incoming data is from a phone number other than one or more phone numbers specified by the user in advance of receiving the incoming call. Chin teaches blocking the notification to the preferred device when the incoming data is from a phone number other than one or more phone numbers specified by the user in advance of receiving the incoming call (fig.2, steps 2k; col.4, lines 63-67). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Cloutier to incorporate the feature of blocking the notification to the preferred device when the incoming data is from a phone number other than one or more phone numbers specified by the

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user in advance of receiving the incoming call in Cloutier's invention as taught by Chin. The motivation for the modification is to do so in order to filter incoming notification based on choice such that the user can easily informed important notification from a particular person.

### ***Conclusion***

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MD S. ELAHEE whose telephone number is (571)272-7536. The examiner can normally be reached on MON-FRI.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, FAN TSANG can be reached on (571)272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MD S ELAHEE/  
MD SHAFIUL ALAM ELAHEE  
Primary Examiner  
Art Unit 2614  
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